

The opinion in support of the decision being entered
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VOLKER PRETZLAFF, ARMIN VON PREETZMANN, and
EDUARD BERGMANN

Appeal 2006-3092
Application 10/601,738
Technology Center 2600

Decided: August 29, 2007

Before KENNETH W. HAIRSTON, JOSEPH L. DIXON, and
SCOTT R. BOALICK, *Administrative Patent Judges*.
DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's Final Rejection of claims 1-3, 5-8, 10, and 11.

We AFFIRM.

BACKGROUND

Appellants' invention relates to a keyless access authorization control device and identification transmitter. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A keyless authorized access control system, the system comprising:

at least two transceivers, each transceiver being assigned to a respective object; and

an identification device having a base module operable to communicate commands to the transceivers assigned to the objects, the base module having at least two interfaces;

the identification device further having at least two object modules, each object module being assigned to a respective one of the objects, each object module having a memory chip containing a code attuned to the assigned object;

each object module being interchangeably connected to the base module through a respective one of the interfaces such that a first one of the object modules is interchangeably connected to the base module through a first one of the interfaces while a second one of the object modules is interchangeably connected to the base module through a second one of the interfaces;

each object module having a button operable for activating the base module to communicate to the transceiver assigned to the object that is assigned to the object module a command having the code attuned to the assigned object when the object

module is connected through the respective one of the interfaces to the base module.

PRIOR ART

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

KURITA	US 5,235,328	Aug. 10. 1993
KING	US 2002/0067826 A1	Jun. 6, 2002

REJECTIONS

Claims 1-3, 5-8, 10, and 11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kurita in view of King.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellants regarding the above-noted rejection, we make reference to the Examiner's Answer (mailed May 3, 2006) for the reasoning in support of the rejections, and to Appellants' Brief (filed Feb. 21, 2006) and Reply Brief (filed May 9, 2006) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to Appellants' Specification and claims, to the applied prior art references, and to the respective positions articulated by Appellants and the Examiner. As a consequence of our review, we make the determinations that follow.

35 U.S.C. § 103

A rejection under 35 U.S.C. § 103(a) must be based on the following factual determinations: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) objective indicia of non-obviousness. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966)).

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161, 82 USPQ2d 1687, 1691 (Fed. Cir. 2007) (quoting *KSR Int’l v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1395 (2007)). “One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims.” *KSR*, 127 S. Ct. at 1742, 82 USPQ2d at 1397.

Discussing the question of obviousness of a claimed combination of elements of prior art, *KSR* explains:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida [v. AG Pro, Inc.]*, 425 U.S. 273, 189 USPQ 449 (1976)] and

Anderson's-Black Rock [Inc. v. Pavement Salvage Co., 396 U.S. 57, 163 USPQ 673 (1969)] are illustrative—a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

KSR, 127 S. Ct. at 1740, 82 USPQ2d at 1396. Where, on the other hand, the claimed subject matter involves more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement, a holding of obviousness must be based on “an apparent reason to combine the known elements in the fashion claimed.” *KSR*, 127 S. Ct. at 1740-41, 82 USPQ2d at 1396. That is, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, 127 S. Ct. at 1741, 82 USPQ2d at 1396 (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)). However, it is not necessary to look only to the problem the patentee was trying to solve; “*any* need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed,” *KSR*, 127 S. Ct. at 1742, 82 USPQ2d at 1397 (emphasis added).

The reasoning given as support for the conclusion of obviousness can be based on interrelated teachings of multiple patents, the effects of demands known to the design community or present in the marketplace, and the background knowledge possessed by a person having ordinary skill in the art. *KSR*, 127 S. Ct. at 1740-41, 82 USPQ2d at 1396. *See also Leapfrog*, 485 F.3d at 1162, 157 82 USPQ2d at 1691 (holding it “obvious to combine the Bevan device with the SSR to update it using modern electronic components in order to gain the commonly understood benefits of such

adaptation, such as decreased size, increased reliability, simplified operation, and reduced cost”).

With respect to the role of the Examiner as finder of fact, the Court of Appeals for the Federal Circuit has stated: “the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR*, 127 S. Ct. at 1741, 82 USPQ2d at 1396 (2007) (quoting *In re Kahn*, 441 F.3d at 988, 78 USPQ2d at 1336 (Fed. Cir. 2006)). Further, as pointed out by our reviewing court, we must first determine the scope of the claim. “[T]he name of the game is the claim.” *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations as recited and disputed in independent claim 1.

From our review of the Examiner's rejection, we conclude that the Examiner has set forth a prima facie case of obviousness of the invention as recited in independent claim 1. Therefore, we look to Appellants' Briefs to show error in the proffered prima facie case.

Appellants' main contention is that it would not have been obvious to one skilled in the art at the time of the invention to have combined the teachings of Kurita and King to achieve the invention as recited in independent claim 1 (Br. 10-11). Specifically, Appellants argue that (i) Kurita and King, when considered as a whole, do not suggest the desirability and thus the obviousness of modifying Kurita in the manner taught by King, and (ii) modifying Kurita in the manner taught by King renders Kurita unsatisfactory for the intended purpose and consequently, there is no suggestion or motivation to make the proposed combination (Br. 11 and Reply Br. 2). Appellants' additionally contend that it would not have been obvious to one of ordinary skill in the art at the time of the invention to combine the plural interfaces of King in the control system of Kurita since Kurita discloses a problem using a single control to control multiple devices in that an operator's control efficiency is low as a result of having to navigate the switches/buttons which are respectively associated with the devices (Reply Brief 2). Therefore, Appellants' argue that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to use plural controls to control plural devices at the same time due to this problem of low operator efficiency associated with using a single control to control devices at a single time.

Appellants additionally argue that Kurita teaches that it is desirable to have only one card electrically connected at any one time to a single control such that the control controls only one device at a time thereby increasing the operator's efficiency (Reply Brief 3). We disagree with Appellants and do not find Appellants' contention commensurate in scope with the instant claim language. We find that the instant claim language is not limited to any specific number of switches and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have had multiple buttons or switches, that were operable to cause communication by one of plural transceivers to an assigned object that is assigned to an object module, that are actuatable at any one time.

Here, Appellants seem to latch onto a problem discussed in Kurita concerning the operator's remote control efficiency when the operator is presented with a high number of switches for operation on a single input menu. Contrary to that, the instant claims merely recite "objects modules" wherein each object module is assigned to a respective one of the objects. Here, we find the instant claim language is much more general than the scope of the specific teachings of Kurita. Additionally, we find it would have been obvious to one of ordinary skill in the relevant art at the time of the invention that with only a limited number of input switches or buttons rather than a large number, to use plural dedicated transceivers with the plural objects modules which are interchangeable with the base module in place of the single transceiver taught by King.

Appellant additionally argues that Kurita teaches away from an arrangement in which two modules (the each having a switch) are electrically connected at a single time to an individual remote control button

in order for the remote control device to control two devices at any specific time. We do not find this argument commensurate in scope with independent claim 1. We find no limitation in independent claim 1 to the actuation of controls at the same time. Therefore, this argument is not persuasive, and we find no express teaching away in Kurita (Brief 12).

Additionally, we find that the combination of King and Kurita would have taught the use of the multiple buttons with a single transceiver. We find that it would have been obvious to one of ordinary skill in the art at the time the invention was made to additionally use plural transceivers for simultaneous control of multiple objects at the one time. We find that those skilled in the art would have appreciated that simultaneous control may be a desirable feature, but the trade-off would have been the additional cost of the additional transceivers. We find those tradeoffs and consideration to have been known to those skilled in the art at the time of the invention and would have been considered by those skilled in the art in a system design.

Appellants additionally argue that the modification of Kurita as proposed by King such that at least two modules are electrically connected at a time to a remote control for controlling plural devices at any time would defeat the purpose of Kurita since the number of switches of the remote control would not be minimized and there would be a loss of operator efficiency in using the remote control (Brief 13). Again, we do not find this argument to be commensurate in scope with the express language of independent claim 1. Therefore, we do not find this argument persuasive. Additionally, we find Appellants' reliance upon the express teachings of Kurita relative to the high number of input switches to not be commensurate in scope with the instant claim language which does not recite more than two

input switches or buttons. Therefore, we do not find Appellants' argument that Kurita would be unsatisfactory for its intended purpose of maximizing remote control operator efficiency to be persuasive. Since we do not find a persuasive argument as to an error in the Examiner's prima facie case of obviousness, we will sustain the rejection of independent claim 1.

Additionally, we will sustain the rejection of independent claims 6 and 11 and the dependent claims 2, 3, 5, 7, 8, and 10 which Appellants have elected to group with independent claim 1.

CONCLUSION

To summarize, we have sustained the rejection of claims 1-3, 5-8, 10, and 11 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

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